REMARKS

Favorable reconsideration of this application in light of the above amendments and the following remarks is respectfully requested.

Claims 1-16 are pending in this application. Claims 1 and 9 are amended herein. No claims have been allowed.

Claim Objections

The Examiner has objected to claims 1 and 9 due to what the Examiner regards as an informality in applicant's use of the terminology "the at."

In response, applicant does not believe that applicant's use of the terminology "the at" is an informality within applicant's application. Applicant in particular notes that applicant claims within claim 1 at line 7 "at least one specified product." Applicant further believes that "the at least one specified product" as cited in part by the Examiner within applicant's claim 1, line 15 derives from proper antecedent correspondence with applicant's "at least one specified product."

In light of the foregoing response, applicant respectfully requests that the Examiner's objections to applicant's claims 1 and 9 be withdrawn.

Claim Rejections - 35 U.S.C. 101

The Examiner has rejected claims 1-8 under 35 U.S.C. § 101 as having no connection to the technological arts.

The Examiner has also suggested that applicant amend applicant's claims to clarify which steps within applicant's claimed invention are performed within the technological arts, in particular those that might be undertaken while employing a computer.

In response applicant has amended both claim 1 and claim 9 in a fashion as suggested by the Examiner to specifically claim computer assistance with respect to the fabrication facility auction capacity aspects of applicant's invention.

Support for newly amended claims 1 and 9 is found within applicant's specification within the second full paragraph on page 18. That portion of applicant's specification teaches that "auction of the auction capacity portion of the total fabrication facility available capacity is typically and preferably undertaken employing a computer system and a distributed communications network as an auction moderator tool . . .."

In light of the foregoing response, applicant respectfully requests that the Examiner's rejections of claims 1-8 under 35 U.S.C. § 101 be withdrawn.

Claim Rejections – 35 U.S.C. 103

The Examiner has rejected claims 1-5 and 9-13 under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al. (U.S. Patent No. 6,047,274; hereinafter "Johnson") in view of McCausland (AMD Seeking Foundry to Fill 2-Year 486 Gap, Electronic News, v 39, n 1964, p 1(2), May 24, 1993; hereinafter "McCausland").

Johnson (title, abstract, background of the invention (as originally cited by applicant)) teaches an auction method for energy supplier bidding for electric and gas energy customer needs. The method is applicable incident to deregulation of traditional dedicated electric and gas supplier to customer relationships since under such circumstances electric and gas energy customer needs may then be supplied by any one of a plurality of suppliers.

McCausland (as cited by the Examiner) teaches the sale or leasing of excess manufacturing capacity within a semiconductor fabrication facility.

The Examiner predicates suggestion or motivation for modification or combination of Johnson's electrical and gas energy supply auction method with McCausland's sale or leasing of excess fabrication capacity within a semiconductor fabrication facility such as to generate extra revenue, as is apparently explicitly taught within McCausland.

In response in a first instance, applicant respectfully submits that Johnson may not properly be employed for rejecting any of applicant's claims to applicant's invention under 35 U.S.C. § 103(a), since Johnson is non-analogous art with respect to applicant's invention.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem to which the invention was concerned." MPEP 2141.01(a) (citing *In re Oetiker* (citation omitted)).

With respect to Johnson's existence in the same field of endeavor as applicant's invention, applicant notes that applicant's invention is directed towards maximizing capacity utilization and consequent economic return within semiconductor fabrication facilities. In comparison, Johnson is directed towards an electric and gas supply auction method intended to enhance competition. Since the dynamics and economics or semiconductor product fabrication (which has never apparently been a regulated industry and where at least some semiconductor products are not necessarily fungible) are fundamentally different from the dynamics and economics of electric and gas supply (which has been a regulated industry and where electric and gas supply are fungible) applicant asserts that Johnson is not in the same field of endeavor as applicant's invention.

For similar reasons, applicant also asserts that Johnson is not "reasonably pertinent to the particular problem to which [applicant's] invention was concerned." Since: (1) Johnson teaches an auction method applicable to fungible electric and gas supplies incident to

deregulation of supplier to customer supply relationships thereof; and (2) applicant's invention teaches an auction method applicable to potentially non-fungible semiconductor fabrication facility capacity within a non-regulated industry, applicant asserts that Johnson's teachings are not reasonably pertinent to applicant's problem. The lack of pertinence of Johnson's teachings to applicant's problem derives from inherent differences between regulated industries in comparison with non-regulated industries, as well as differences and limitations of auctions with respect to fungible materials in comparison with non-fungible materials.

In summary, since Johnson is neither within applicant's field of endeavor nor reasonably pertinent to the problem to wards which applicant's invention is directed, applicant asserts that Johnson may not properly be employed for rejecting any of applicant's claims to applicant's invention in combination with other references under 35 U.S.C. § 103(a).

In response in a second instance, applicant also asserts that McCausland may also not properly be employed in conjunction with other references for rejecting any of applicant's claims to applicant's invention insofar as McCausland teaches away from applicant's claimed invention.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP 2141.02 (citing *W.L. Gore Associates, Inc. v. Garlock, Inc.* (citation omitted))

Applicant again notes that the Examiner accurately cites McCausland as teaching that enhanced revenues may be obtained by selling or leasing unutilized capacity within a semiconductor fabrication facility. However, McCausland also teaches that the sale or leasing of the capacity is determined "'on a case by case basis'." Thus, McCausland clearly implicitly or inherently, if not explicitly, teaches no apparent intention for an auction for disposition of excess semiconductor fabrication facility capacity, since there is no indication that a group of parties

would be pre-qualified such as to provide a pool of bidders for purposes of bidding on unused capacity otherwise intended for sale or lease. Rather, McCausland teaches that individual proposals for purchase or lease of excess capacity would be evaluated on "'a case by case basis.'" Applicant understands the "'case by case basis'" would require individual analysis of individual proposals absent any auction.

Since applicant's invention is directed towards an auction method for utilization of excess capacity within a semiconductor fabrication facility and McCausland implicitly or inherently if not explicitly teaches absence of an auction method, applicant asserts that McCausland may not properly be employed for rejecting any of applicant's claims to applicant's invention in combination with other references under 35 U.S.C. § 103(a).

In response in a third instance, applicant asserts that even if Johnson and McCausland might properly be employed for rejecting applicant's claims to applicant's invention, Johnson nonetheless may not properly be modified or combined with McCausland for reasons as cited by the Examiner to provide applicant's claimed invention. Applicant further asserts that while those reasons are apparently derived from and applicable to McCausland, they are at least in part nonetheless not applicable to Johnson.

Applicant again notes that McCausland is directed towards a sale or lease of excess capacity within a semiconductor fabrication facility such as to provide increased revenue. In comparison, Johnson (abstract) teaches that within Johnson's electric and gas supply auction method pricing may be adjusted either upward or downward such as to either decrease or increase projected energy consumption in a specific area. Thus, Johnson clearly intends circumstances where Johnson's auction method would provide reduced revenue due to a price increase in a specific geographic region. Also, since in general Johnson's method is directed towards an auction method intended to stimulate competition, applicant notes in general that increased competition provides for lower purchase costs and lower seller revenue when selling

products. Thus, Johnson's method in general implicitly or inherently teaches reduced revenues for an electric and gas supplier rather than increased revenues.

Thus, since McCausland's invention would in all circumstances provide for increased revenue incident to sale or lease of unused semiconductor fabrication facility capacity in other than an auction format, while Johnson's electric and gas supply auction is intended to generally result in decreased revenues for electric and gas suppliers with increased costs and increased revenues for electric and gas suppliers with reduced costs, applicant asserts that Johnson may not properly be combined with McCausland for reasons as cited by the Examiner. The reasons as cited by the Examiner, which are directed towards increased revenues, are clearly not generally applicable within Johnson since Johnson's auction method would generally decrease revenues for electric and gas suppliers since Johnson's auction stimulates competition which in general results in decreased costs.

In light of the foregoing responses, applicant respectfully requests that the Examiner's rejections of claims 1-5 and 9-13 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of McCausland be withdrawn.

Claims 6-8 and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of McCausland and further in view of Ausubel (U.S. Patent No. 5,905,975).

Ausubel is cited (abstract) as teaching various types of auction formats.

In response with respect to claims 6, 8, 14 and 16, applicant predicates the patentability of claims 6, 8, 14 and 16 upon their dependence upon claims 1 or 9.

In response with respect to claims 7 and 15, applicant is unable to locate within Johnson, McCausland, Ausubel either individually or as combined by the Examiner any teaching of use of an auction price for an auctioned capacity of a semiconductor fabrication facility capacity for setting a price for an unauctioned capacity for the semiconductor fabrication facility.

Thus, since each and every limitation within applicant's invention as disclosed and claimed within claims 7 and 15 is not taught within Johnson, McCausland and Ausubel as combined by the Examiner, applicant asserts that claims 7 and 15 may not properly be rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of McCausland and further in view of Ausubel.

In light of the foregoing response, applicant respectfully requests that the Examiner rejections of claims 6-8 and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of McCausland and further in view of Ausubel be withdrawn.

Other Considerations

Applicant acknowledges that additional prior art of record cited on form PTO-892 but not employed in rejecting applicant's claims to applicant's invention, as generally pertinent to applicant's invention. No fee is due as a result of this amendment and response.

SUMMARY

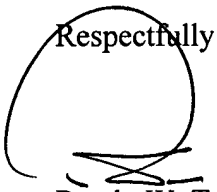
Applicant's invention as disclosed and claimed within claim 1 and claim 9 is directed towards a capacity auction method as applied to a fabrication facility, and in particular a microelectronic fabrication facility. The prior art of record may not properly be employed for rejecting applicant's claims to applicant's invention for reasons related to non-analogous art and teaching away. The prior art of record may also not properly be combined to provide applicant's claimed invention since there exists no suggestion or motivation for the same.

CONCLUSION

On the basis of the above amendments and remarks, reconsideration of this application, and its early allowance, are respectfully requested.

Any inquiries relating to this or earlier communications pertaining to this application may be directed to the undersigned attorney at 248-540-4040.

Respectfully submitted,



Randy W. Tung (Reg. No. 31,311)

838 West Long Lake Road - Suite 120
Bloomfield Hills, MI 48302
248-540-4040 (voice)
248-540-4035 (facsimile)